REMARKS

This Amendment is in response to the Office Action identified above, and is further responsive in any other manner indicated below.

PENDING CLAIMS

Claims 1, 5, 6, 10, 12 and 14-19 were pending, under consideration and subjected to examination in the Office Action. Appropriate claims have been amended, deleted and/or added in order to adjust a clarity and/or focus of Applicant's claimed invention. Such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is present interested. At entry of this paper, Claims 6 and 16 remain pending for further consideration and examination in the present application.

Applicant respectfully submits that one or more continuing applications directed to the canceled claims and to other limitations/features of the present invention may be timely filed.

ALLOWED CLAIMS

Claims 6 and 16 were allowed in the application, as indicated at Item 10 on page 5 of the Office Action. Renewal of the allowance is respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowable subject matter.

CLAIM OBJECTION - TRAVERSED

Claim 10 was objected to for the reasons set forth in Item 2 on page 2 of the Office Action. Since Claim 10 has been canceled herein (without prejudice or disclaimer), reconsideration and withdrawal of the objection are respectfully requested.

ALL REJECTIONS UNDER 35 USC §§102 AND 103 - TRAVERSED

All 35 USC rejections (*i.e.*, §102 rejection of Claims 1, 12 and 15 as being anticipated by Yamazoe (JP 04-250423); the §102 rejection of Claims 10 and 17 as being anticipated by Nakajima (JP 11-014994); the §103 rejection of Claim 14 as being unpatentable over Yamazoe in view of Osaki *et al.* (JP 05-107543); the §103 rejection of Claim 5 as being unpatentable over Yamazoe in view of Osaki *et al.*, and further in view of Sugawara *et al.* (JP 11-258609); and the §103 rejection of Claims 18 and 19 as being unpatentable over Yamazoe in view of Afzali-Ardakani *et al.* (US 5,571,852 A)) are respectfully traversed. Such rejections have been rendered obsolete by the present cancellation of all rejected claims (without prejudice or disclaimer), and accordingly, traversal arguments are not appropriate at this time. However, for the record, Applicant respectfully offers the following remarks.

Unrelated to any prior art rejection, Claims 1-5, 7-15 and 17-19 have been cancelled without prejudice or disclaimer of any scope or subject matter, thus rendering any rejection of such claims obsolete at this time. The above and following statements, and/or the cancellation of any rejected claim(s) (without prejudice or disclaimer), should not be taken as any indication or admission that any

of the art is substantively relevant or that any of the rejections has valid, but is merely use of a procedural approach to expedite prosecution to obtain issue of a patent on the present application.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

In order to properly support a §102 anticipatory-type rejection, any applied art reference must disclose each and every limitation of any rejected claim. In order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited art does not adequately support either a §102 anticipation-type rejection or a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) Applicant's invention.

More specifically, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it

would be so recognized by persons of ordinary skill." Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. With regard to the requirements to support a rejection under 35 USC §103, reference is made to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO can satisfy the burden of showing under §103 by some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the Court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. As further noted by the Court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court reversed an obviousness rejection and indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is "basic" or "common" knowledge.

Applicant respectfully submits that, in view of the requirements for §§102/103 rejections, none of the applied prior art teaches or suggests the present invention, absent improper "hindsight" application.

Moreover, Applicant respectfully traverses the continued characterization of the applied art. For example, Item 11 on page 7 of the Action states, "Yamazoe meets every limitations (*sic.*) recited in the claims, especially, a charge control member (8 and 9) is brought into contact with a rubbing surface of the rubbing cloth to control the static electric charge." Applicant respectfully strongly traverses such characterization of Yamazoe. In the English language Patent Abstract of Japan for Yamazoe, the "Constitution" states, "A rod or foil type conductor 8 which contacts the fiber 7 and a means 9 which short-circuits the conductor 8 and a rubbing table 1 electrically are provided to evade the generation of the static electricity" (emphasis added). Therefore, Yamazoe is not interested in controlling the electric charge, merely grounding it, and Yamazoe does not teach or suggest any of the novel features of the present invention. It is therefore respectfully submitted that the characterization of Yamazoe is in error.

Applicant also respectfully traverses the statement made as the final paragraph in Item 11 on page 8, "...however, the limitations recited in the claims do not clearly point out the patentable novelty of the claimed invention." There is no supportive explanation given for such a statement, and there is no citation of any specific limitation/feature which is not clearly recited and positively claimed. Indeed, throughout the 21 April 2004 Action, there is no factual rebuttal of any kind of any of the statements made in the voluminous and substantive arguments traversing the rejections which Applicant presented in the Amendment filed 6 February 2004.

As a result of all of the foregoing, it is respectfully submitted that none of the applied art would support a §102 anticipatory-type rejection or §103 obviousness-

type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §§102 and 103 rejections, and express written allowance of all pending claims, are respectfully requested.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

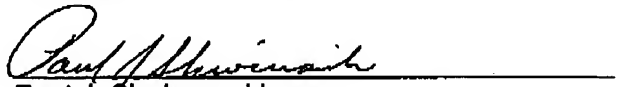
The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600 to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that all the claims listed above as presently pending are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

This Amendment is being submitted within the shortened statutory period for response set by the Office Action mailed 21 April 2004, and therefore, no Petition or extension fee is required for entry of this paper. To whatever other extent is actually appropriate and necessary, Applicant respectfully petitions for an extension of time under 37 CFR §1.136. Further, no additional claim fees are required for entry of this Amendment. Please charge any fees due to ATSK Deposit Account No. 01-2135 (as Case 520.41012X00).

Respectfully submitted,



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